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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,827	05/11/2001	Alex Lang	4989-009	6461

27820 7590 02/02/2007  
WITHROW & TERRANOVA, P.L.L.C.  
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SUITE 160  
CARY, NC 27518

EXAMINER
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CERVETTI, DAVID GARCIA

ART UNIT	PAPER NUMBER
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2136

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/02/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/853,827

Applicant(s)

LANG ET AL.

Examiner

David G. Cervetti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-11,13-20 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-11,13-20 and 22-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

1. Applicant's arguments filed October 26, 2006, have been fully considered but they are not persuasive.

2. Claims 1-7, 9-11, 13-20, and 22-26 are pending and have been examined.

Claims 8, 12, and 21 had been cancelled previously.

### ***Response to Amendment***

3. Contrary to Applicant's statements on pages 2-3, MPEP 2144 clearly states that

"The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (setting forth test for implicit teachings); In re Eli Lilly & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985) (examiner must present convincing line of reasoning supporting rejection); and Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning)."

4. Adding security to something that previously lacked it, Examiner submits is a strong reason for combining the two references, one needs only look at Applicant's specification, "Background of the Invention", pages 1-3, where CSPs are described (admitted prior art). Furthermore, regarding the alleged failure in teaching identifying as a first device and as a second device type, the broad language of the claims reads perfectly on Thomas et al. (US Patent 6,529,992, hereinafter Thomas) teachings of automatic execution of an application upon insertion, the reading of the media as a first known device occurs when the media is inserted (first device type) and the identification of the media as a second device type occurs when the stored application executes

(second device type). More specifically, Thomas teaches USB port (col. 5, lines 1-67, which reads on identifying as a first device type) and further teaches executing automatically an application residing on the inserted device (col. 6, lines 1-67, which reads on identifying the device as a second device, automatically, and configuring itself to work with it). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. If Applicant's first and second device type are patentably distinct from Thomas, Applicant is encouraged to amend the claims to include further limitations of what the metes and bounds of such "first and second device types" are intended to be. **Applicant's arguments are not persuasive.**

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. **Claims 1-7, 9-11, 13-20, and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. (U.S. Patent No. 6,529,992, hereinafter Thomas), and further in view of Spies et al. (U.S. Patent No. 6,055,314, hereinafter Spies).**

**Regarding claims 1, 13, and 23, Thomas teaches**

- a portable device for engaging a host computing device comprising:
- a body(fig. 2);
- a memory within the body containing (fig. 2, ref. num.52):

- initial identification indicia to initially identify the portable device to the host computing device as a first device type in which a driver for the first device type is known to the host computing device (col. 5, lines 25-44);
- cleansing indicia providing instructions for the host computing device to remove at least certain information from the host computing device indicative of use of the host computing device while associated with the portable device (fig. 3, ref. num 228-234); and
- an interface associated with the memory and adapted to facilitate interaction with the host computing device (fig. 2, ref. num 102),
- wherein the host computing device will detect the portable device as being the first device type and configure itself to interact with the portable device to provide the application for the applications running on the host computing device (col. 4, lines 8-16).

Thomas does not teach software instructions to subsequently identify the portable device as a cryptographic service provider/second device type to the host computing device and provide a driver for the cryptographic service provider to allow the host computing device to effectively interact with the portable device to provide cryptography services for applications running on the host computing system, and wherein the host computer further configures itself to provide cryptographic services for the applications running on the host computing device.

Spies teaches

- software instructions to subsequently identify the portable device as a cryptographic service provider/second device type to the host computing device and provide a driver for the cryptographic service provider to allow the host computing device to effectively interact with the portable device to provide cryptography services for applications running on the host computing system (fig. 6, ref. num 104),
- and wherein the host computer further configures itself to provide cryptographic services for the applications running on the host computing device(col. 12, lines 41-44).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine subsequently identifying the portable device as a second type/cryptographic service provider, and configuring the host to provide the cryptographic services to applications on the host, as taught by Spies, with the device of Thomas. It would have been obvious for such modifications because configuring the host computer to run the applications from the portable device allows a user to maintain everything he or she needs, while using a portable disk (Thomas, col. 4, lines 8-16). The added benefit of cryptography services provided to the host computing device allows an end-to-end encryption of data to ensure all data is stored encrypted (Spies, col. 3, lines 5-63).

**Regarding claims 17 and 22, Thomas teaches**

- a method comprising:

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- Identifying a portable device to a host computing device as a first device type, which is known to the host computing device (col. 5, lines 25-44);
- Registering the portable device with the host computing device as the first device type (fig. 4); and
- Removing at least certain information from the host computing device indicative of use of the host computing device while associated with the portable device (fig. 3, ref. num 228-234).

Thomas does not teach automatically identifying the portable device to the host computing device as a cryptographic service provider/second device type; enabling the portable device as the cryptographic service provider/second device type with the host computing device based on information provided on the portable device; and providing cryptography services for applications running on the host computing device based on the information provided by the portable device.

Spies teaches

- automatically identifying the portable device to the host computing device as a cryptographic service provider/second device type (fig. 6, ref. num 104);
- enabling the portable device as the cryptographic service provider/second device type with the host computing device based on information provided on the portable device (col. 12, lines 41-44); and
- providing cryptography services for applications running on the host computing device based on the information provided by the portable device (col. 11, line 64 through col. 12, line 1).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine identifying the portable device as a cryptographic service provider, enabling the portable device as a cryptographic service provider, and providing cryptography for applications running on the host computer, as taught by Spies, with the method of Thomas.

It would have been obvious for such modifications because configuring the host computer to run the applications from the portable device allows a user to maintain everything he or she needs, while using a portable disk (Thomas, col. 4, lines 8-16). The added benefit of cryptography services provided to the host computing device allows an end-to-end encryption of data to ensure all data is stored encrypted (Spies, col. 3, lines 5-63).

**Regarding claim 2**, Thomas as modified by Spies teaches wherein the memory further contains service indicia providing instructions to provide a service corresponding the cryptographic service provider (Spies, fig. 6, ref. num 118).

**Regarding claims 3 and 14**, Thomas as modified by Spies teaches wherein the service indicia includes instructions for the host computing device to provide the service for applications running on the host computing device (Thomas, col. 4, lines 8-16).

**Regarding claims 4 and 16**, Thomas as modified by Spies teaches further comprising a processing unit associated with said memory and wherein the service indicia includes configuration instructions for said processing unit to provide the cryptography service for the host computing device (Thomas, fig. 2, ref. num 106).



**Regarding claim 5**, Thomas as modified by Spies teaches wherein the configuration indicia includes a file executable on the host computing device to reconfigure the host computing device to recognize and interact with the portable device as the cryptographic service provider (Thomas, fig. 4 and Spies, fig. 6, ref. Num 118).

**Regarding claim 6**, Thomas as modified by Spies teaches wherein the memory further contains an application to run on the host computing device (Thomas, col. 4, lines 8-16).

**Regarding claims 7 and 18**, Thomas as modified by Spies teaches wherein the first device type is a storage device (Thomas, col. 5, lines 25-44).

**Regarding claim 9**, Thomas as modified by Spies teaches wherein said memory further contains at least one of the group consisting of private cryptography key, public cryptography key, and cryptography algorithm (Spies, col. 11, lines 40-63).

**Regarding claim 10**, Thomas as modified by Spies teaches wherein the interface is one of the group consisting of electrical, optical, and radio frequency (Thomas, fig. 2, ref. num 102).

**Regarding claims 11 and 20**, Thomas as modified by Spies teaches wherein the memory further contains deregistering indicia providing instructions for the host computing device to reconfigure the host computing device to a configuration state prior to interacting with the portable device (Thomas, col. 9, lines 35-46).

**Regarding claim 15**, Thomas as modified by Spies teaches wherein the configuration instructions to provide the cryptography services are configured for running on the host computing device (Spies, col. 11, line 64 through col. 12, line 38).

**Regarding claim 19**, Thomas as modified by Spies teaches wherein the second device type is a cryptographic service provider (Spies, fig. 6, ref. num 118).

**Regarding claim 24**, Thomas as modified by Spies teaches wherein the body and memory are integrally formed with one another such that the memory is not readily removed from the body (Thomas, fig. 2, all components are sealed in a single package).

**Regarding claim 25**, Thomas as modified by Spies teaches wherein the memory contains at least four megabytes of flash memory (Thomas, col. 4, lines 44-56, Zip disks are well known to have more than 4 MB's of memory).

**Regarding claim 26**, Thomas as modified by Spies teaches wherein the cleansing indicia includes instructions to de-register the cryptographic service provider so as to prevent access to selected functions, services, and drivers after the portable device has been removed (Thomas, col. 9, lines 35-46).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

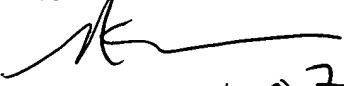
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David G. Cervetti whose telephone number is (571) 272-5861. The examiner can normally be reached on Monday-Friday 7:00 am - 5:00 pm, off on Wednesday.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on (571) 272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DGC

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